

REMARKS

Office action summary

Claims 19-28 and 33-47 are pending in the present application. Claims 19, 33-40, and 42-45 are presently amended. No claims are presently added or canceled. The following rejections were made in the office action of September 17, 2009 (“Office Action”):

- Claims 19-20, 24-27, 33-34, 36-39, 41-44, and 46-47 were rejected under 35 USC § 103(a) as being unpatentable over Alexander et al, US Patent 6,177,931 (“Alexander”), in view of Plotnick et al, US Patent Application Publication 2002/0184047 (“Plotnick”)
- Claims 21-22, 35, 40, and 45 were rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick, and further in view of Official Notice.
- Claim 23 was rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick, and further in view of Tsuchiya et al, US Patent 6,201,777 (“Tsuchiya”).
- Claim 28 was rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick, and further in view of Fisher et al, US Patent 5,835,896 (“Fisher”).

The rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants’ undersigned attorney, Jon M. Isaacson, at **206-332-1102**.

Telephonic interview

On October 16, 2009, applicants’ undersigned attorney and Examiner Nguyen-Ba conducted a telephonic interview. Applicants’ undersigned attorney would like to thank the examiner for granting the interview. During the interview, applicants arguments were discussed without reaching any formal agreement. Any further substance of the interview is incorporated into the remarks below.

Rejections under 35 USC § 103(a)

Claim 19

Claim 19 stands rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick. The Office Action acknowledges that Alexander fails to disclose a number of recitations of claim 19. (Office Action, page 3.) The Office Action relies on Plotnick's paragraphs 0047-0049 to teach those recitations of claim 19 not taught by Alexander. (*Id.* at pages 3-4.) However, applicants respectfully submit that Plotnick does not qualify as prior art for subject matter in paragraphs 0047-0049 for at least the following reasons.

A published US application can be used as a prior art reference against an applicant's invention if it was "filed in the United States before the invention by the applicant." (35 USC § 102(e).) In addition, when a published application claims priority to a provisional application, the reference date of the application is the filing date of the provisional application "if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." (MPEP § 2136.03 (emphasis in original).) The present application was filed on January 4, 2002. Plotnick was filed on a later date, on April 3, 2002. Thus, relying alone on its filing date, Plotnick does not qualify as prior art under 35 USC § 102(e). However, Plotnick does claim priority to provisional application 60/281,037, filed on April 3, 2001 (the '037 application), and to provisional application 60/329,992, filed on October 17, 2001 (the '992 application). Applicants' undersigned attorney reviewed the '037 application and the '992 application, and is unable to discern any portion of the '037 application and the '992 application which supports the subject matter relied upon in the office action.

More specifically, claim 19 recites, in part "displaying at least one of the plurality of advertisements during a first insertion point...wherein display of an advertisement during the first insertion point is deemed appropriate based on a subscription level of the user" and "continuing display of the entertainment content without displaying an advertisement during a second insertion point, wherein the display of an advertisement during the second insertion point is deemed inappropriate based on the subscription level of a user." Applicants submit that the '037 application and the '992 application fail to support any determination of

displaying advertisements “based on a subscription level of a user.” The ‘037 application does states that “advertisement opportunities are created based on the analysis of various motion vectors” so that “advertisements that do appear on crucial moments in the story line and are found to be less intrusive.” (‘037 application, page 19, ¶ 5.) However, this teaching fails to support the matter relied on in Plotnick to teach “displaying at least one of the plurality of advertisements during a first insertion point...wherein display of an advertisement during the first insertion point is deemed appropriate based on a subscription level of the user” and “continuing display of the entertainment content without displaying an advertisement during a second insertion point, wherein the display of an advertisement during the second insertion point is deemed inappropriate based on the subscription level of a user,” as recited by claim 19.

Therefore, applicants submit that Plotnick, for the subject matter relied upon by the office action, qualifies as a reference only as of its filing date. And, as Plotnick’s filing date is after the filing date of the present application, applicants submit that Plotnick does not qualify as prior art for the subject matter relied upon by the Office Action. Because Plotnick does not qualify as prior art for the subject matter relied upon, and because Alexander fails to teach a number of the recitations of claim 19, applicants submit that claim 19 is patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claim 19 under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick.

Claims 20-28 and 33-47

Claims 19-20, 24-27, 33-34, 36-39, 41-44, and 46-47 stand rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick. Claims 21-22, 35, 40, and 45 stand rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick, and further in view of Official Notice. Claim 23 stands rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick, and further in view of Tsuchiya. Claim 28 stands rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Plotnick, and further in view of Fisher.

The rejections of each of claims 20-28 and 33-47 rely on the subject matter of Plotnick cited against claim 19. (Office Action, pages 4-10.) Inasmuch as Plotnick does not

qualify as prior art for the subject matter cited against claim 19, as discussed above, applicants submit that claims 20-28 and 33-47 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejections of claims 20-28 and 33-47 under 35 USC § 103(a).

Claim 21

In addition to the reasons stated above, applicants respectfully request withdrawal of the rejections of claim 21 for the following reasons. The rejection of claim 21 relies on Official Notice to argue that the following recitation of claim 21 is well known in the art: “receiving entertainment content on a medium having a hardware security feature such that display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature.” (Office Action, page 7.) The Office Action states that this recitation of claim 21 is “well known in the art as circuit (e.g. V-chip) designed to selective blocking audio and video signals for preventing the receiver to display [offensive content].” (*Id.*) Without conceding that Official Notice is properly taken, applicants believe the alleged Official Notice to teach that a receiver with a V-chip circuit selectively blocks audio and visual signals based on the signal’s content. Applicants respectfully submit that the recitation of claim 21 is not taught or suggested by the alleged Official Notice for at least the following reasons.

First, applicants respectfully submit that the alleged Official Notice fails to teach or suggest “receiving entertainment content on a medium having a hardware security feature,” as recited by claim 21. The alleged Official Notice teaches only receiving an audiovisual signal. Applicants are unable to discern how receiving an audio visual *signal* teaches receiving “receiving entertainment content *on a medium* with a *hardware security feature*,” as recited by claim 21. (Emphasis added.)

Second, applicants respectfully submit that the alleged Official Notice fails to teach or suggest that “display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature,” as recited by claim 21. The alleged Official Notice teaches a receiver with a circuit that selectively blocks audio and visual signals based on the signal’s content. While the alleged Official Notice may teach a receiver with a circuit, it teaches that the display of the audiovisual signal is selectively

blocked based on the signal's content. In contrast to the teachings of the alleged Official Notice, claim 21 recites that the "display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature." Applicants submit that the selectively blocking entertainment based on content of the alleged Official Notice fails to teach or suggest a player device including hardware compatible with a hardware security feature of a medium.

For at least these additional reasons, applicants submit that claim 21 is patentably defined over the cited art. According, applicants request withdrawal of the rejection of claim 21 under 35 USC § 103(a).

Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 19-28 and 33-47 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

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